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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,547	06/14/2006	Patrick Schifrine	0512-1318	9488
466	7590	02/26/2008		
YOUNG & THOMPSON			EXAMINER	
209 Madison Street			FISHER, ELANA BETH	
Suite 500			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314			3733	
		MAIL DATE	DELIVERY MODE	
		02/26/2008	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/564,547	<b>Applicant(s)</b> SCHIFRINE ET AL.
	<b>Examiner</b> ELANA B. FISHER	<b>Art Unit</b> 3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 January 2006.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 13 January 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-166/08)  
 Paper No(s)/Mail Date 04/19/2006
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 9 recites the limitation "size estimation component" in the end of the second line and beginning of the third line of the claim. There is insufficient antecedent basis for this limitation in the claim.

3. Claims 1, 5 and 8 recite the limitation "the plate" in line seventeen of the claim and line of the claim, respectively. It is unclear as to which plate the applicant is referring to (whether it is the original plate of the tensioning component or the tibial plate stated thereafter), therefore here is insufficient antecedent basis for this limitation in the claim.

4. Claim 3 recites the limitation "the plate" in the second line of the claim and additionally recites the limitation "the component" in the third line of the claim. There is insufficient antecedent basis for these limitations in the claim.

5. Claim 7 recites the limitation "guiding means" in the second to last line of the claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferrante et al. (U.S. Patent 5,364,401).

- a. Regarding claim 1, Ferrante et al. disclose device for positioning a total knee prosthesis comprising a tensioning component (10) having:
- a plate (16) which is capable of being supported on a tibial cutting surface
  - a slide (20) which is capable of being displaced on a sliding means (24) in a direction substantially perpendicular relative to the plate and which has means (42) for being temporarily fixedly joined to an ancillary component (see diagram provided) which comprises a centro-medullary rod (72) and a tibial plate (62) and which is capable of receiving adjusting means of variable thicknesses (at location 42; Column 3, lines 49-52)
  - and a motor means (66 and 68; Column 6, lines 59-64) which allows the surgeon to displace the slide (20) and tension the knee when the plate is pressed on the tibial cut and the ancillary component (FIG 5)
  - a drilling guide (see diagram) which is capable of being mounted on the sliding means (24) and which has drilled holes (around 42) which allow the subsequent positioning on the femur of a cutting block which allows the posterior femoral cuts to be brought about (Column 3, lines 49-52 and Column 5, lines 59-60), the guide being able to comprise or be associated with a means for palpating the anterior portion of the femur in order to position the guide in alignment with this anterior portion (Column 3, line 49-53)
  - and reference means (30) which determine the position of the slide (20) and/or the guide relative to the plate (16) of the tensioning component (FIG 1) and therefore determine the interarticular space available in a state of flexion (Column 3, lines 61-66)

the device thus allowing either the position of the distal femoral cutting plane to be determined by determining the difference between the spacing in the state of extension and the space in the state of flexion, or, in the case of a distal cut which is carried out immediately, the position of the posterior femoral cutting plane to be determined in order to obtain approximate equality between the spacing in the state of extension and the space in the state of flexion (Column 7, lines 5-17).

b. Regarding claim 2, the device further comprises a size estimation component (28) which is capable of being mounted on the sliding means (24) in order to be able to estimate, using a reference means (30), the size of the femur and allow the correct drill guide component to be selected (Column 7, lines 5-17).

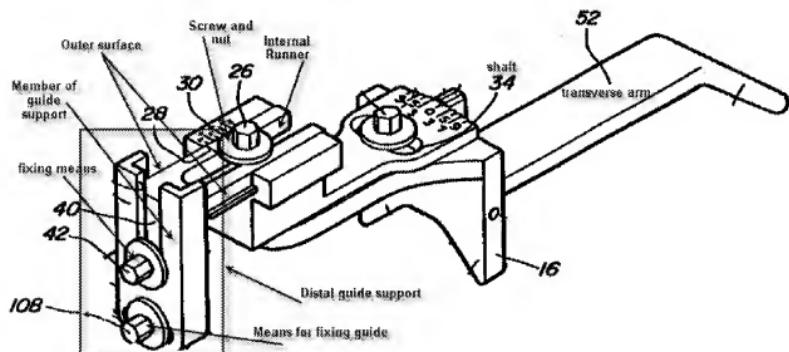
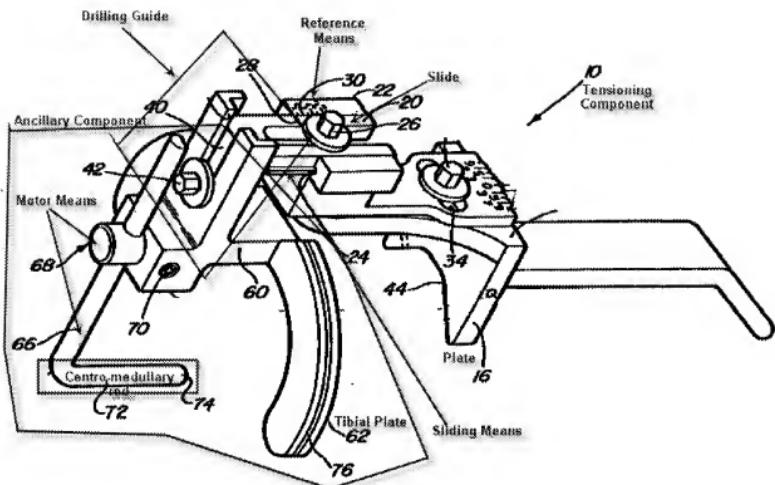
c. Regarding claim 3, the plate (16) is dimensioned such that the femoral end can be received between the plate and the component (28), in the manner of a calliper rule (FIG 4; Column 7, lines 5-17).

d. Regarding claim 4, the device further comprises a distal cutting guide support (see diagram provided) which has a member (40) which is capable of sliding on the sliding means (24) and from which an arm (see diagram provided) extends which will extend parallel with the axis of the knee in a state of flexion, and which has means for receiving and fixing the distal cutting guide at a precise location (108).

e. Regarding claim 5, the tensioning component (10) comprises, extending from the plate (16), sliding means (24), on or in which the slide (20) is capable of sliding, this slide (20) being able to be displaced by means of an assembly comprising a screw and a nut (26).

- f. Regarding claim 6, in that the sliding means (24) have an internal runner (see diagram provided) in which the slide (20) is guided, and an outer surface (see diagram provided) which allows the drilling guide and other components of the device to be guided, the slide having a portion which allows the drilling guide to be moved on this device (see diagram provided; Column 3 lines 42-43 and lines 49-52).
- g. Regarding claim 7, the drilling guide (see diagram provided) is constructed so as to receive a palpating arm (FIG 3, 82) which is capable of pressing on the anterior surface of the femoral end (shown in FIG 6) in which limits the insertion of the guide on the guiding means.
- h. Regarding claim 8, the slide (20) has relieves (26) which allow precise positioning, relative to the slide, of the plate (62) of the ancillary component and a rapid fixing means (42) which allows the plate (62) to be temporarily fixedly joined relative to the slide (20).
- i. Regarding claim 9, there is a size estimation component (28) formed in one piece with a member (22) that is capable of sliding on the sliding means (24). The member has a transverse arm (52) which is articulated about a shaft (34) that is parallel with the sliding axis (horizontal axis).

Regarding the above claims see figures 1, 3-6, and the diagrams on the following page.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELANA B. FISHER whose telephone number is (571)270-3643. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571)272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elana B Fisher/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733